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09/322,594 05/28/99 PETKOVSEK

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EXAMINER

HENDERSON, M

ART UNIT

PAPER NUMBER

3722

DATE MAILED:

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7

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/322,594

Applicant(s)

Glenn Petkovsek

Examiner

Mark T. Henderson

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on Mar 23, 2001

2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-20 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1-20 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☒ The proposed drawing correction filed on Mar 23, 2001 is: a) ☒ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____.
- ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

20) ☐ Other: _____

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DETAILED ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXING of responses to Office Actions directly into the Group at (703)305-3579. This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. The drawings have been amended to overcome previous objections.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-15 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Petkovsek (5,697,648).

Petkovsek discloses in Fig. 1, 2 and 6, a mailing assembly comprising a backing sheet (11), first and second mailing forms (10a and 10b) removably attached to the backing sheet by an adhesive (Col. 6, lines 21-25) and separable by a tear line (60) wherein the forms includes a first return postcard (18) integrally formed with a designator section (24) which is contained within the first exterior sides (29a and 33a) that define the postcard; wherein the first mailing form (10a) is removably attached (60) to the second mailing form (10b); wherein the second mailing form (Fig. 6) has a second return postcard (18b) integrally formed with a second designator section which is contained within the second exterior sides of the second return postcard; a first anchor portion (28) extending outside one of the exterior sides (33a) of the first return postcard, wherein the first anchor portion has adhesive (48) on the backside (Fig. 2), is removably attached to the postcard via a tear line (33) a removable label section (30) attached to the first anchor portion (28) via a tear line (32), a third designator section (36) contained within the first anchor portion, and a second anchor portion (27) removably attached to the return postcard by a tear line (29).

However, Petkovsek does not disclose a designator section; indicative of a special service which includes one of certified, registered, insured mail, COD and return receipt; ~~having a machine-readable code~~; and is distinctly colored.

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In regards to Claims 1 and 7-9, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have any desirable indicia in the designator section since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983). Also, in the present case, there appears to be no new or unobvious structural relationship between the printed matter and the substrate.

Furthermore in regards to Claim 8, matters related to the choice of ornamentation producing no mechanical effect or advantage considered to constitute the invention are considered obvious and do not impart patentability, *In re Seid* 73 USPQ 431.

In regards to Claims 13-15, the method for preparing a mailpiece for delivery is inherently taught by Petkovsek.

3. Claims 16-20 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Walz (5,664,725).

Walz discloses in Fig.1, 4 and 5, a mailing assembly comprising a first mailing form (84) having a first postcard (70), a first anchor portion (58) and a removably attached to the postcard via a tear line (24), wherein the first anchor has adhesive (16) on the backside of the anchor (seen in Fig. 5), a first backing strip (49) received over the adhesive on the anchor portion's backside,

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an integrally formed first section (73) indicative of other services (Col. 4, lines 40-53), an area (66) contained within the postcard printed with machine readable code (75), and a second form (82) removably attached to the first form by a tear line (20).

However, Walz does not disclose: a second mailing form having a second postcard and a second anchor portion; a first return postcard having no adhesive; and a designator section indicative of a special service.

In regards to Claim 16, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have any desirable indicia in the designator section since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983). Also, in the present case, there appears to be no new or unobvious structural relationship between the printed matter and the substrate.

Also, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include any desirable amount of mailing forms with postcards and anchor portions, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to omit the adhesive on the underside of the postcard, since it has been

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held that omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art. *In re Karlson*, 136 USPQ 184.

Response to Arguments

4. Applicant's arguments filed on March 23, 2001 have been fully considered but they are not persuasive.

In response to applicant's argument that the Petkovsek and Walz references do not disclose a designator section within the exterior sides that define a postcard wherein the designator section is integrally formed with the return postcard, the examiner submits that both Petkovsek and Walz discloses a designator section in Fig. 1 as set forth in the above 103 rejections.

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Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)305-3579. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.

MTH

MTH

May 31, 2001


HENRY TSAI
PRIMARY EXAMINER
5/31/01